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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,545	01/10/2002	Altaf Mulla	482XB	9646
7590	12/31/2003			
Kirschstein, Ottinger, Israel & Schiffmiller, P.C. 489 Fifth Avenue New York, NY 10017-6105			EXAMINER LEE, DIANE I	
			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,545

Applicant(s)

MULLA ET AL.

Examiner

D. I. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 310 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed 16 October 2003. Claims 10, 12-17, and 20-29 have been canceled; and claims 30-34 have been newly added. Currently claims 30-34 are pending in this application.
2. Receipt is also acknowledged of the Terminal Disclaimer filed 16 October 2003 to overcome the Double Patenting Rejection (37 CFR §1.321(c)). The terminal disclaimer filed on 16 October 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,119,944 has been reviewed and is accepted. The terminal disclaimer has been recorded.
3. It is noted that the effective filing date for the currently claimed invention remains 08 January 1999 for the specific claimed feature (i.e., *one of the components being movable between a first position and a second position relative to the window*) has not been “wholly” disclosed until application Serial No. 09/227,245) (see the previous office actions).

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 December 24, 2003 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 30-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang [US 5,617,304] in view of Plesko [US 5,506,394], Barkan [US 6,098,877-referred as Barkan], and Kobayashi et al. [US 4,129,369-referred as Kobayashi].**

Re claims 30-31 and 34: Huang discloses a portable optical instrument having a combination of ballpoint pen 10 as a marker facing the surface to be marked during the marking mode (i.e., writing mode) and laser pointing unit 20 for creating a visual display on a target during a pointing/aiming mode of operation (see col. 1, lines 59+ and figures 1 and 4), the instrument comprising:

the portable, hand-held housing having a size and a shape configured to be held in a user's hand during both marking and aiming or pointing mode. The housing is elongated and extends along an axis between opposite end regions, and wherein the marker is located at one of the end regions and the pointer is located at other end regions (see figure 4). The housing having marker located at one end of the regions of housing (i.e., a ball point pen as a writing instrument supported by the housing) and the pointer at other end of the regions (see the abstract, col. 2, lines 39+ and figure 4) (see col. 1, lines 16-23 and 59-63; col. 2, figures 1, 4). The housing bounds an interior in which the internal component 22 is

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accommodated. The housing as separable portions 10, 20, which upon separation, enabling an access to the interior and an exterior clip 25 for clipping the housing to a part of the user's clothing (see col. 1, line 59-col. 2, line 43 and figure 1).

a laser emitter 224 supported by the housing 20 for emitting a laser light beam along a path outwardly of the housing towards the target and producing a beam pattern (e.g., a spot scan pattern) on the target when in a pointing mode in which a visual display is created on the target (see col. 1, lines 29-38; col. 2, lines 1-42; and figures 1-4).

Huang does not disclose the apparatus having plurality of optical components to electro-optically read coded indicia as set forth in the claims.

Plesko discloses a stylus beam-scanning device for utilizing as a bar code scanning device (see the abstract). The indicia reader/scanner housing having a size and shape configured to be held in a user's hand during reading mode (see figure 1). Plesko shows the scanner having a plurality of electrical and optical components supported by the housing, including a laser light source for generating and directing the light beam as a visible laser beam along an optical path, a light sensor having a field of view over the indicia during the reading mode and for generating an electrical signal indicative of the detected light, a manually actuatable trigger 2, and etc. (see figures 1-5). When scanning the indicia, the light transmissive element of the housing faces the indicia and the light directed by the laser light source passes in one direction through the element and the reflected light passes in an opposite direction through the element to be detected by the light sensor having a field of view (see figures 7-8), and for generating an electrical signal indicative of the detected light (see col. 17, lines 9+). The front-end 16A of the scanner housing where the light enters and exits as indicated by 6, 7 in figure 7 serves as a window, and the window is oriented generally perpendicular to a longitudinal axis of the reader. The detector 14 detects the light reflected off the coded indicia and generates an electrical signal indicative of the detected light intensity (see col. 17, lines 9+). Plesko further discloses the reader having a processor 35 for decoding the

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electrical signal into data represented by the coded indicia, a memory for storing the data within the housing (see col. 16, lines 9-16; col. 18, lines 1-8), a scanning module 100 as a drive supported by the housing for scanning the emitted laser light beam across the target (see col. 16, lines 27+ and figure 8), and a manually actuatable switch 2 for activating the detector to enable the unit to activate the scan sequence (see col. 15, lines 61+), and a data output (an infrared emitting diode 31) located back of the scanning module for downloading the electrical signal stored by the processor to a host remote from the instrument (see col. 16, lines 9+). Plesko further discloses that the stylus beam-scanning device can be utilized as a laser pointer (see col. 18, lines 14). The scan module drive for moving the laser light beam along a path outwardly of the housing towards the target and producing a beam pattern (e.g., a spot, a line, or an elliptical scan pattern) on the target when in a pointing mode in which a visual display is created on the target (see col. 18, lines 14+).

In view of Plesko's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the scanning system in the pointer unit of Huang in order to provide a dual optical device that utilize as an aiming device which target can be pointed or highlighted and as a reader capable of reading bar code. Accordingly, such modification would provide greater capability and more feasible system. Therefore, it would have been an obvious expedient.

Although Plesko teaches that the data output port is located end of the pen as an ideal location for a typical cordless data link, Huang as modified by Plesko does not expressly show the data output port at the window. However, an artisan of ordinary skill in the art at the time the invention was made to recognize that the window and the marker of the instrument as taught by Huang as modified by Plesko are located at opposite end regions of the housing and the location of the data output port can be anywhere within the housing so long as it is capable of downloading the electrical signal stored by the processor to a host remote from the instrument. Thus, the specific claimed location of the data output port, i.e., at the window, would have been obvious to one having ordinary skill in the art at the time the invention was

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made to arrange the data output port location in vicinity to the electro-optically reading means, preferably located end of the a pen on the electro-optically reading region as an ideal location for a typical cordless data link, since it has been held that rearranging parts of an invention involves only routine skill in the art. Since it appears that the invention would perform equally well with different orientation and due to lack of criticality, the arrangement of the data output port placement within the housing is not seen to be patentable. Accordingly, it would have been an obvious expedient.

Huang as modified by Plesko fails to teach the instrument having one of the electrical and optical component movable between a two position (i.e., a first position for a first foci in pointing and a second position for a second foci in reading) and an actuatable switch operatively connected to move the component between positions to selectively focus the light beam at the first and second foci in the pointing and reading mode)

Barkan discloses a scanner having a dual optic system having two focusing lens 172a, 172b to provide a dual reading mode (i.e., a short range and long range reading mode) and a positioning trigger to selectively actuating the each reading mode. Therefore, the positioning trigger moves the dual optic system between the positions to selectively focus the light beam at the first foci and the second foci in the reading mode to selectively read the indicia located within one of the working distances or working ranges. Wherein the positions of focusing lens are located in and out of the optical path (see col. 14, lines 66+ and figure 16B).

In view of Barkan's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the dual mode scanning system in instrument of Huang as modified by Plesko in order to provide a different range of reading capability when reading coded indicia.

Re claim 32: Huang as modified by Plesko and Barkan fails to teach the optical component having a focusing lens and the specific switch that manually moving the component by the actuatable switch.

Kobayashi discloses a camera having a focusing lens (a close-up lens 2) that may be selectively movable into and out of the optical path to selectively provide photographic condition. Wherein the close-up lens 2 is supported by the lens frame 2b. The lens frame having a switching means (selector portion 2a which projects outside the camera body A) for slidingly move the close-up lens 2 into and out of the optical path, i.e., the selector portion 2a mounted on the camera housing for movement by the user and operatively connected to the lens 2 for manually moving the lens by the selector 2a (see col. 2, lines 54+ and figures 11).

In view of Kobayashi's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the manual switching means in the instrument of Huang as modified by Plesko and Barkan in order to simplified the switching structure and to reduce the manufacturing costs of the instrument.

8. **Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang as modified by Plesko, Barkan, Kobayashi, and Kumar as applied to claim1 above, and further in view of Kubota et al. [US 5,956,021].** The teachings of Huang as modified by Plesko, Barkan, and Kobayashi have been discussed above.

Although pen or hand held device is often utilized as a touch screen for a convince, Huang as modified by Plesko, Barkan, and Kobayashi is silent with respect to the writing instrument being a stylus for a touch screen of portable computer.

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Kubota discloses an input device with a touch screen having a LCD panel 106 and tablet 108 and wherein the LCD panel displays representative keys to be selected by a stylus pen 109 (see the abstract and col. 1, lines 8-13, col. 2, lines 50+).

In view of Kubota's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to extend the use of the writing instrument of Huang as modified by Plesko, Barkan, and Kobayashi in order obtain a device that further utilize for inputting information on portable computer as well as on the paper.

Response to Arguments

9. Applicant's arguments with respect to newly added feature in claim 30, which directed to a data output port 103 at the window 96 for downloading the electrical signal indicative of the indicia and stored in memory 100 as shown in figure 2 of the applicant's disclosure and the prior art does not disclose or suggest the data output port feature have been considered but are moot in view of the new ground(s) of rejection (see the discussion above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Note: After January 15, 2004, the examiner can be reached on 571-272-2399 and the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398.

A handwritten signature in black ink, appearing to read "D. I. Lee".

D. I. Lee
Primary Examiner
Art Unit 2876

D. L.